

Action dated December 28, 1995, were withdrawn. Further, agreement was reached that an interference should be declared between the instant application and Martin because at least one claim in the application is allowable and is directed to the same patentable invention as Martin (e.g., applicants' claim 19 is identical to Martin claim 1). See 37 C.F.R. 1.601(i).

Accordingly, formal allowance of applicants' pending claims 1 and 19-38, and the declaration of an interference with Martin et al. is respectfully requested. The interference should be set up in the manner proposed in applicants' "Preliminary Amendment and Request that an Interference Be Declared Under 37 C.F.R. § 1.607" filed March 28, 1995 (hereinafter "Applicants' Interference Request").

I. The Office Action dated December 28, 1995

In the Office Action, the Examiner rejected the specification and claims 19-37 under 35 U.S.C. § 112, first paragraph, as failing to provide disclosure for the following:

1) a septum lying substantially at a right angle to a plane essentially defined by the proximal and distal portions (see independent claim 19);

2) the angle contained between the proximal and distal portions specifically being 0-20 degrees (see dependent claims 29, 34 and 37); and

3) the proximal portion [of the body] being more rigid than the distal portion (see dependent claim 36).

Additionally, claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Nos. 4,405,313 (Sisley). Claim 1 was further rejected under 35 U.S.C. § 102(e) as being anticipated by either of U.S. Patent Nos. 4,981,477 (Schon) and 5,171,216 (Dasse).

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000

Similarly, claims 19-38 were rejected under 35 U.S.C. § 102(b) as anticipated by or obvious over Sisley. These claims were further rejected under 35 U.S.C. § 102(e) as anticipated by or obvious over Schon and Dasse.

Also, in the Office Action, the Examiner objected to the deletion of certain language in the specification, presented in Applicants' Preliminary Amendment filed March 28, 1995, on the ground that it introduced new matter.

II. Withdrawal of each of the Rejections of the Claims

A. 35 U.S.C. § 112

As explained during the interview, and as agreed upon by the Examiner, applicants support each of the three limitations identified by the Examiner. Accordingly, formal withdrawal of the rejection under 35 U.S.C. § 112 is respectfully requested.

To summarize statements made during the interview, applicants have the following comments. Reference is made to the claim chart that was attached as Exhibit B to Applicants' Interference Request (courtesy copy attached), which shows where support for applicants' claims is found in both applicants' present application and in applicants' parent application (U.S. Ser. No. 07/461,684, filed January 8, 1990).¹

As agreed by the Examiner during the interview, the septum limitation in applicants' claims (see claim 19) is clearly

¹ As explained in Applicants' Interference Request, p. 6, fn. 1, the specification for U.S. Patent No. 5,209,723 is nearly identical to the specification for the as-filed parent application. Therefore, for convenience, the '723 patent (attached as Exhibit C to the Interference Request) is referred to in the claim chart when demonstrating where support may be found for the claims in the parent application.

supported in the present and parent applications. Referring to page 3 of Exhibit B, the septum defining two lumens is supported in the present application at Fig. 2; page 14 and in the parent application at Fig. 2; col. 4, lines 60-61 (see partition 22 in Fig. 2). Further, referring to Fig. 1 and 3 of the present and parent applications, the dashed line demonstrates the right angle orientation of the partition 22 with respect to the plane defined by the curved catheter.

The Examiner also agreed that the recitation of an angle contained between the proximal and distal portions of the catheter in the range of 0-20° (see, e.g., dependent claim 29) is also supported in the present and parent applications. Referring to page 6 of Exhibit B, support for this limitation is found at Figs. 3 and 4; pp. 18-19 in the present application and at Figs. 3 and 4; col. 6, lines 34-44 in the parent application. Note that the "almost a 180° angle throughout section 58" disclosed is substantially the same as an angle of near 0°, as the angle is defined in claim 29 and other claims containing this limitation. The applicant simply defined the angle shown in Figs. 3 and 4 of the specification in terms of the amount the catheter was angled back from a straight configuration throughout section 58, rather than define the angle between the proximal and distal portions of the catheter. These angles, of course, are complementary. Thus, and as is evident from Figs. 3 and 4, the "almost 180°" angle described in the specification is substantially the same as almost 0°, as the angle is defined in the claims.

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

The Examiner also agreed that the recitation of a proximal portion of the catheter that is more rigid than the distal portion (see claim 36) is supported in the present and parent applications. Referring to page 8 of Exhibit B, support for this limitation may be found at Fig. 5, pages 6 and 20 in the present application and at Fig. 5, col. 3, lines 11-18 and col. 7, lines 4-14 of the parent application. In particular, the proximal catheter end is provided with a tubular prong member that is made of plastic, which is more rigid than the distal catheter end.

B. 35 U.S.C. § 102/§ 103

As explained during the interview, and as agreed upon by the Examiner, none of the following references, either alone or in combination discloses or suggests the claimed invention. Accordingly, formal withdrawal of the rejections of the claims under 35 U.S.C. §§ 102 and 103 is respectfully requested. To summarize statements made during the interview, applicants have the following comments:

1. U.S. Patent No. 4,405,313 (Sisley)

Sisley is directed to a catheter having a "figure 8" type dual lumen with "fill in" portions at 16 and 18 to address blood leakage. The catheter in Sisley, however, is not "generally U-shape in its natural, unstressed configuration" as recited, for example, in claim 1.

2. U.S. Patent No. 4,981,477 (Schon)

Schon is directed to a catheter for suctioning fluids out of the lungs, not a catheter for hemodialysis. The distal end

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

has a "w-shape" to allow the device to weave into the lungs, in the manner shown in Figs. 3 and 4. However, the Schon device is not "generally U-shape in its natural, unstressed configuration" as recited, for example, in claim 1.

3. U.S. Patent No. 5,171,216 (Dasse)

Dasse relates to a coupling device that is surgically inserted under the skin. Referring to Fig. 8, the catheter attached to the coupling is not "generally U-shape in its natural unstressed configuration" as recited, for example, in claim 1.

C. Objection Under 35 U.S.C. § 132

As explained during the interview, the amendment objected to by the Examiner was made in order to be consistent with amendments to the specification in the parent case, U.S. Ser. No. 08/045,016. The amendment in the parent case was made in response to an objection to the specification by the Examiner. See U.S. Serial No. 08/045,016, Office Action dated February 2, 1994, page 2, ¶ 3 (Paper No. 8.) The amendment overcame the Examiner's objection. See Amendment dated May 2, 1994, page 1. Accordingly, withdrawal of this new matter rejection is respectfully requested.

III. Proposal for How the Interference Should be Structured

A. The Count Should be the Broadest Allowable Claim Supported by Both Parties

The count should be at least as broad as the broadest allowable claim to either party that would correspond to the count. See 37 C.F.R. 1.601(f) (the count "should be broad enough to encompass all of the claims that are patentable over

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000

the prior art and designated to correspond to the count".)

Therefore, the count should be applicant's claim 1.

Applicants' claim 1 is broader in certain respects than Martin et al. claim 1. For example, applicants' claim 1 recites a catheter defining an arc angle that is "generally U-shape in its natural, unstressed configuration", whereas Martin claim 1 recites a permanently curved portion of the catheter that is "less than 90°".

Also, applicants' claim 1 omits reference to the septum recited in Martin claim 1. As reflected by the Examiner's withdrawal of all rejections as to independent claims 1 and 38, neither of which recite the septum limitation, such a limitation is not necessary to patentability. Applicant supports this limitation and recites it in another allowable claim (see claim 19), however, the double "D shaped" lumen formed by the septum is a feature that is known in the art and is not a necessary feature for patentability. Thus, it should not be incorporated in the interference count.

Applicants refer the Examiner to Applicants' Interference Request filed March 28, 1995, pp. 9-11, for a further discussion of the possible interference counts and the structure of the interference.

B. Applicants Should be Accorded the Benefit of the Filing Date of its Parent Application when the Interference is Declared

As explained in Applicants' Interference Request filed March 28, 1995 (pp. 11-12 and Exhibit B), applicants should be accorded the benefit of their parent application, U.S. Serial

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

No. 461,684, filed January 8, 1990, when this interference is declared.

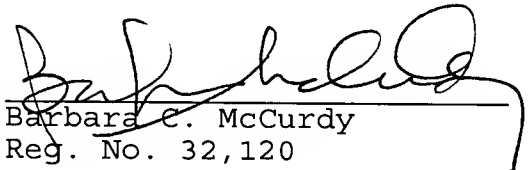
IV. Information Disclosure Statement

The information disclosure statement filed herewith under separate cover cites the reference of record in the parent cases for this application. Additionally, the references cited in the prosecution history of the Martin et al. patent are included.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


Barbara E. McCurdy
Reg. No. 32,120

Date: March 28, 1996

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000